

STATUS OF CLAIMS

Claims 1 through 29 were pending in this application.

Claims 19 through 29 have been withdrawn from consideration without prejudice.

Claims 1 through 3, 5 through 9 and 12 through 18 stand rejected by the Examiner.

Claims 4, 10 and 11 have been objected to.

Claim 30 has been added.

Claims 1 through 18 and 30 are now pending in this application.

REMARKS

In view of the remarks which follow, Applicant respectfully requests reconsideration of the subject application.

35 U.S.C. §103 Claim Rejections

Claims 1-3, 5-9, and 12-18 stand rejected as being unpatentable over United States Patent No. 3,846,199 to Cappelli (hereinafter "Cappelli") in view of United States Patent No. 5,735,895 to Rinehart (hereinafter "Rinehart"). Applicant notes with appreciation that the Examiner acknowledges the patentability of Claims 4, 10 and 11, albeit if written in independent form. Nevertheless, Applicant respectfully traverses the rejection and objections to Claims 1 - 18 for at least the following reasons.

Turning now to the specifics of the Examiner's rejections, 35 U.S.C. 103(a) sets forth in part:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time of the invention was

made to a person having ordinary skill in the art to which said subject matter pertains.

The Office bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). To establish a *prima facie* case of obviousness, all of the recited claim limitations must be taught or suggested in the prior art. *See*, MPEP 2143.03; *see also*, *In re. Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The mere fact that references can be combined or modified does not render the resultant combination obvious. *See*, M.P.E.P. §2143.01; *see also*, *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Instead, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. *See*, M.P.E.P. §706.02(j); *see also*, *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

To determine whether there was an apparent reason to combine the known elements, an explicit analysis of the interrelated teachings of the cited references has to be made. *See*, *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. _____, slip op. 14, (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”)) In such an explicit analysis, each cited reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v.*

Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Applicant respectfully submits that the cited references, either separately or in combination, fail to either teach or suggest at least each of the limitations of Claims 1 through 18 and new Claim 30. As an initial matter, and in accordance with independent Claims 1, 18 and 30, it should be noted that Applicant's invention is directed to an artificial eye comprising pre-formed glass components which are fused together. The fusion of glass, as opposed to other substrates, such as plastic, provides for a more precisely and consistently colored, polished and anatomically realistic eye without the need for highly trained artisans or technicians.

In the Examiner's view, Cappelli discloses an artificial eye comprising at least four pre-formed components fused together; those components comprising a base component, a pupil component, an iris component, and a cornea component. The Examiner concedes, however, that Cappelli fails to teach that the components are made of glass. In order to overcome this deficiency, the Examiner concludes that:

. . . an artificial glass eye is very well known in the art as evidenced by Rinehart.

While artificial glass eyes may be known in the art, the Examiner has not shown that constructing such eyes by fusing together pre-formed glass components would have been obvious to one skilled in the art. In this regard, the Examiner merely concludes, without any suggestion in the references or evidence of motivation, that it would have been obvious to combine Cappelli and Rinehart.

As stated in by the Supreme Court in *KSR v. Teleflex*:

. . . there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

Here, the Examiner has not articulated the reasoning which supports the rejection of Claims 1-3, 5-9, and 12-18 under 35 U.S.C. §103. Rather, the Examiner merely concludes that such a combination would have been obvious merely because glass has been used as substrate in artificial eyes. However, independent Claims 1, 18, and 30 recite more than a glass substrate. Instead, the invention of Claims 1 and 30 comprises pre-formed glass components fused together. Claim 18 comprises a pressed glass blank having the graphics of the eye contained thereon. Nowhere do the cited references teach or suggest such structures. Accordingly, applicant respectfully requests reconsideration and allowance of such claims.

Accordingly, Applicant submits that at least independent Claims 1, 18 and 30 are patentably distinct over the prior art of record. Applicant further submits that Claims 2 through 17 are similarly distinguishable over the prior art of record, at least by their ultimate dependency from patentably distinct independent Claim 1.

The Examiner also has rejected Claims 8, 9, and 15-18, under 35.U.S.C. § 103 as being unpatentable over Cappelli in view of Rinehart. Although the Examiner concedes that neither Cappelli nor Rinehart teach the various decorative features set forth therein, the Examiner, states that:

. . . such features are merely for decorative purpose [sic] and it would have been a matter of design choice to incorporate a desired decorative material and/or color to enhance the aesthetic appearance of the artificial glass eye.

Again, the Examiner fails to articulate the reason that such features would have been obvious to one of ordinary skill in the art. Instead, the Examiner merely concludes that the decorative material and/or color was “a matter of design choice.” In this regard, Claims 8, 9 and 15-18 do not introduce merely decorative limitations. Rather, the limitations introduced are structural and not merely “design choice.” For example, in Claim 8, the pupil component

comprises a pellet pressed disk or bead of glass. In Claim 9, the eye further comprises a dusting of finely powdered glass. In Claim 15, the eye graphics comprise a decal. And finally, in Claim 18, the base component comprises a pressed glass blank.

Thus, the Examiner has not properly characterized the limitations of Claims 8, 9 and 15-18 inasmuch as the limitations introduced are specifically structural and not merely “a matter of design choice.”

For the foregoing reasons, Applicant submits that Claims 1 through 18 and 30 are patentably distinct over the prior art of record. Accordingly, Applicant respectfully requests early and favorable disposition of Claims 1 through 18 and 30.

Request for Interview

Applicant respectfully requests the courtesy of a telephonic interview with the Examiner upon receipt of this Response in order to expedite the prosecution of this application.

CONCLUSION

Wherefore, Applicant believes that all outstanding grounds raised by the Examiner have been addressed and requests reconsideration of the instant application. Accordingly, Applicant respectfully submits that the present case is in condition for allowance, the early notification of which is earnestly solicited.

The Commissioner is hereby authorized to charge any deficiencies or credit any overpayment related to this submission to Deposit Account Number 50-0979.

Respectfully submitted,



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